

REMARKS

Claims 21 to 32 were pending in the application at the time of examination. Claims 21 to 32 stand rejected as anticipated. Claims 21 to 32 stand provisionally rejected for obviousness-type double patenting.

Applicant has amended the specification to provide the current status of the non-provisional parent application and the serial numbers of the copending divisional applications.

The Examiner objected to Claims 22 and 28. Applicant has amended these claims as suggested by the Examiner to remove the informality. Reconsideration and withdrawal of the objection to Claims 22 and 28 is respectfully requested.

The Examiner also objected to Claims 27 to 32. Applicant has amended Claim 27 as suggested by the Examiner to remove the informality. Reconsideration and withdrawal of the objection to Claims 27 to 32 is respectfully requested.

Claims 22 and 27 recite a method that uses a novel single hardware I/O block structure for both mirrored and non-mirrored transactions. As noted below, the prior art reference does not disclose a single hardware I/O block structure, but instead system commands that are sometimes referred to as "channel program commands" in the reference. To avoid a discussion on whether Applicant was requesting the Examiner to read limitations from the specification into the claims in interpreting what constituted a hardware I/O block structure, Applicant has amended Claims 22 and 27 to recite an inherent feature of such structures.

Claims 21 to 32 stand rejected under 25 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,155,845, hereinafter referred to as "Beal." In the rejection, the Examiner cited to Fig. 17 and the use of the structure in Fig. 17 in an extended dual copy feature and an extended connectivity feature of Beal.

Applicant respectfully traverses the rejections of Claim 21 and 27. The structure cited by the Examiner is used to configure a data storage control unit and a pair of volumes so that subsequent standard write commands function properly. Specifically, Beal stated:

DSC 105 interprets the reception of the commands and information of FIGS. 14-17 as being a request from the host to prepare itself for the provision of extended dual copy service to a pair of specified volumes when the above-described standard DASD channel commands are subsequently received requesting the writing of a data record to the locally specified volume of DSC 105.
(Emphasis added.)

Beal, Col. 19, lines 61 to 68. Thus, Beal explicitly teaches that the commands cited by the Examiner are used to configure "DSC 105" and it is subsequent standard DASD channel commands that request writing of data. The same is true for the Extended Connectivity Service.

The structure relied upon by the Examiner is not a hardware I/O command block structure as recited and used in the method of Claims 21 and 27. In fact with the prior art, two different command sequences, a command sequence to configure DSC 105 and a subsequent standard DASD channel command, are needed to accomplish a write. In contrast, all this information is conveyed in the single hardware I/O command block structure as recited in the method of Claims 21 and 27. Thus, Beal not only fails to teach exactly what is claimed, but teaches away from the method recited in Claims 21 and 27. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 21 and 27.

Claims 22 to 26 depend from Claim 21 and so distinguish over Beal for at least the same reasons as Claim 21. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 22 to 26.

Claims 28 to 32 depend from Claim 27 and so distinguish over Beal for at least the same reasons as Claim 27. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 28 to 32.

Claims 21 to 32 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 27, and 29 to 33 of copending U.S. Patent Application 10/779,417, hereinafter referred to as "AN417."

Applicant respectfully traverses the obviousness-type double patenting rejection. In the parent Application of the instant application and of AN417, the Examiner stated:

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17 drawn to a mirrored write data transaction . . .
- II. Claims 18-19 drawn to control block structures . . .
- III. Claim 20 drawn to command chaining. . .
- IV. Claim 21 drawn to mode selection. . .

The MPEP makes it clear that claims subject to a restriction requirement cannot later be rejected for obviousness-type double patenting because such a rejection renders the original restriction requirement meaningless.

The novel feature in claims 21 to 32 in the instant application were characterized by the Examiner as related "to mode selection," as quoted above. The claims in U.S. Application No. 10/799,417 include original claims 18 and 19 and so Claims 27, and 29 to 33 in AN417 were characterized by the Examiner as related "to control block structures." The fact that the novel characteristics are recited in a system in AN417 does not change the fundamental character of the novel

features. Accordingly, to hold that claims, in which the novel features are the features upon which the original restriction was based, are subject to obviousness-type double patenting is inappropriate and makes the original restriction requirement meaningless. In view of the restriction requirement, the Examiner is estopped from asserting the obviousness-type double patenting rejection. Applicant respectfully requests reconsideration and withdrawal of the obviousness-type double patenting rejection of each of Claims 21 to 32.

Claims 21 to 32 remain in the application. Claims 21, 22, 27 and 28 have been amended. Claims 1 to 19 were previously canceled. For the foregoing reasons, Applicant respectfully requests allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on November 12, 2004.


Attorney for Applicant(s)

November 12, 2004
Date of Signature

Respectfully submitted,



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